REMARKS

Reconsideration and withdrawal of the rejections of the pending claims are respectfully requested in view of the amendments and remarks herein, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-4 and 7-20 remain pending in the application.

Claim 1 has been amended for clarification by removal of brackets on the methylene group directly connected to the saccharide and recitation of "n is 0 or 1"; suggesting the methylene group is required. For example see published US Application 10/544,281; Table 1 (page 25) compounds including but not limited to 1.2, 1.4 and 1 conform to the claims as currently amended. Claims 1, 9, 10, 13, 15, 17 and 18 have been amended such that substituents R2, R4 and R6 exclude $-SR_9$, $-S(=O)R_{11}$, $-S(=O)_2R_{11}$, $-CH_2-S(=O)_2R_{11}$; these particular substitutions are not contemplated by the specification of the instant application.

No new matter has been added by these amendments.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. §§§§ 101, 102, 103 and 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE REJECTIONS UNDER 35 U.S.C. § 103 ARE OVERCOME

Claims 1-4, 7-10, 13, 15-20 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious with respect to US 5,169,839 (Linn). Applicants respectfully disagree.

The Supreme Court has recently reaffirmed the factors set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18: "[T]he scope and content of the prior art are determined; differences between the prior art and the claims at issue are...ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as

commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727. Furthermore, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Although the Applicants do not agree with the Office Action, in the interest of expediting prosecution, claims 1, 10, 13, 15, 17-20 have been amended to delete the recitation of n = 0. The recitation of n = 0 removes the condition for which R2, R4 and R6 overlap with the claims in Linn (US 5,169,839).

Claims 1-4, and 7-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 5,208,222(Meinke). The Examiner contends that one of ordinary skill in the art would have been motivated to prepare homologues based on the teachings of Meinke(5,028,222) rendering the Applicant's claimed material obvious under 35 U.S.C. § 103(a). Although the Applicants do not agree with the Office Action, in the interest of expediting prosecution, claims 1, 9, 10, 13, 15, 17 and 18 have been amended such that substituents R2, R4 and R6 exclude -SR_9, -$S(=O)R_{11}$, -$S(=O)_2R_{11}$, -CH_2-$S(=O)_2R_{11}$ which Meinke teaches thus removing the contention of obviousness.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are respectfully requested.

II. THE NONSTATUTORY DOUBLE PATENTING REJECTIONS ARE OVERCOME

Claims 1-4, 7-10, 13, 15-20 are rejected on the grounds of nonstatutory obviousness –type double patenting.

Applicants reiterate that the issue of whether there is indeed double patenting is contingent upon whether the instant claims herewith are indeed considered and, if so, whether the Examiner believes there is overlap with the claims ultimately allowed in the instant

application and of application No.10/543,643, 10/543,637, 10/560,390, l0/568,715 and of 10/599,671. Regarding the citation of claims 1 of 10/516,839 titled "Use of benzo[c]quinolizinium derivatives for the treatment of diseases that are linked to smooth muscle cell constriction " appears to the Applicant to have no bearing on the instant application. If, upon agreement as to allowable subject matter, it is believed that there is still a double patenting issue, a Terminal Disclaimer as to 10/544,281 will be considered.

Accordingly, reconsideration and withdrawal of the double patenting rejection, or at least holding it in abeyance until agreement is reached as to allowable subject matter, are respectfully requested.

REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance, an interview with the Examiner and SPE is respectfully requested, prior to issuance of any paper other than a Notice of Allowance; and, the Examiner is respectfully requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

CONCLUSION

For the reasons stated above, Applicants respectfully request a favorable reconsideration of the application, reconsideration and withdrawal of the rejections of the pending claims, and prompt issuance of a Notice of Allowance.

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